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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,474	06/12/2001	Jamal Benbrahim	IGTECH.0013P	5212
7590 08/09/2004			EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE, SUITE 6300 CHICAGO, IL 60606-6357			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/880,474

Applicant(s)

BENBRAHIM, JAMAL

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-17 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**



**In response to the RCE filed 5-03-2004.**

**The previously indicated allowable subject matter of claims 16 and 17 has been withdrawn.**

**Claims 1-10 and 13-17 are rejected.**



***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10<sup>th</sup> 2004 has been entered.

***Claim Objections***

Claims 5, is objected to because of the following informalities: the typo "d\_cryption d\_vice" as found on 10 has been interpreted to be "decryption device". Appropriate correction is required.

Claims 10, is objected to because of the following informalities: the typo "a controll\_r adapted to use said decrypt\_d" as found on 14 has been interpreted to "a controller adapted to use said decrypted". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 & 13-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the encryption/decryption of game data, does not reasonably provide enablement for the encryption/decryption of game data “during operation”. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to realize (make and/or use) the invention commensurate in scope with these claims. While the specification provides for the protection of game data no similar language and/or functionality is provided for in either the referenced paragraphs 38, 52, and 61 or the remainder of the specification as so originally filed, that would provide support the claimed method and apparatus wherein the protection functionality is handled concurrently with the operation of a game.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 and 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneier et al (US 6,264,557).

Schneier teaches a method for securing electronic games including:

Encrypting game device operational code with a first private key transmitted to the encryption device and storing the encrypted code in a memory device (Abstract & Elm 215).

Obtaining said game device operational code reversibly/symmetrically encrypted with said first private key during game play (Elm 620 & Figure 15);

Providing said encrypted code to said game device through transmitting (630);

Storing the encrypted code at said gaming device;

Locating a decryption device (Col 2:21-29 & Col 9:21-36);

Decrypting said encrypted code using said first private key to recover said code (Col 2:21-29 & Col 9:21-36);

Storing said decrypted code at said gaming device; and

Utilizing said decrypted code to control at least one aspect of the operation of said gaming device during operation of said gaming device by the player (Col 2:21-29 & Col 9:21-36).

Where the storing of the encrypted code and decrypted code in a gaming device memory are considered inherently required for the decrypted code to be utilized by the gaming device as data and likewise the storing of the encrypted code would be inherently required in order to allow the manipulation of the encrypted code by the cryptographic processor (decryption device) of the gaming device to decrypt.

The processing of the encrypted data is considered concurrent (during) to the operation of the wager device by the player as the data transferred is described and a random number utilized in the determination of a win or loss.

Regarding at least claim 7, the described "secure access module" interpreted as element 296 or 275 and is associated with the encryption device (210) as so claimed.

Regarding at least claim 8, Schneier teaches data authentication (1750).

Regarding at least claim 9, the transmission of the first key to the decryption device is demonstrated in figure 2 where the key databases are separate from the cryptographic processor and as such must be transmitted to the cryptographic processor for use.

Regarding at least claim 10, the "control code" effecting the location of said private decryption key is considered treated for the same reason present in the address of claim 9 above.

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Regarding at least claim 14, Schneier teaches the use of RAM (215).

Regarding at least claim 15 the disclosed communication link over remote distances (remote locations) is shown in figure 1.

Regarding at least claims 16 and 17, the system of Schneier teaches the generation of a random number by the player device and the server device, which is understood as a first portion and a second portion of operational data. Both of the portions are then encrypted by the respective device, which generated the data and transferred to the alternate device. At least one key is then transferred to one of the devices in order to allow the decryption of the previously encrypted data for use in the determination of a game event (Col 8:33-10:16).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al (US 6,264,557) as applied to claim 10 above and in further view of Nguyen (US 2002/0071557).

Scheier is silent regarding the transfer of executable code. In a related application however Nguyen teaches the transfer of software between a remote server and a game machine while utilizing symmetric encryption (Para 16-20). It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the transfer of executable code as taught by Nguyen in the device of Schneier in order to allow for updating of game software or to reduce game distribution costs by pushing new games to old machines.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-10 and 13-17 have been considered but are moot in view of the new ground(s) of rejection.

Though moot the Hash function of Alcorn meets the most basic definition of a symmetric encryption method and as previously presented would the claims as previously presented. In interests of furthering prosecution however the Schneier et al reference has replaced Alcorn for it's clear demonstration of Symmetric encryption techniques.

Further the applicant's arguments/amendments towards a concurrent encryption validation method and game execution are unclear. It would seem that the execution of



the device executable code can only be accomplished once the code is in fact decrypted and therefore could not occur during the play of the game. The only reasonable conclusion in this case is that the code executed and decrypted are not the same portion of code. Presently however, no support has been demonstrated for this type of read ahead buffering system capable of performing the task as set forth.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

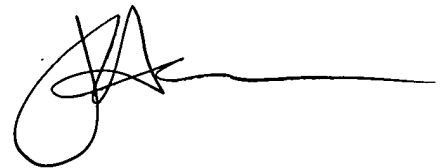
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**JESSICA HARRISON**  
**PRIMARY EXAMINER**